

REMARKS

The following remarks are responsive to the Office Action dated May 13, 2002.

Claims 1-12 are pending.

The Examiner has rejected claims 1-12 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,473,144 to Mathurin, Jr. ("Mathurin") in view of U.S. Patent No. 5,768,389 to Ishii ("Ishii").

Rejection Under 35 U.S.C. § 103(a)

Applicant respectfully submits that claims 1-12 are not rendered unpatentable over Mathurin in view of Ishii under 35 U.S.C. § 103(a). In order to meet this burden, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP § 2143; In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Applicants respectfully submit that neither Mathurin nor Ishii, individually or in combination, meet these requirements to render claims 1-12 unpatentable under 35 U.S.C. § 103(a). Specifically, neither Mathurin nor Ishii, individually or in combination, teach or suggest each and every limitation of the claims.

Independent claims 1 and 12 recite a security system having a combination of elements including, *inter alia*, the elements of: a chip card reader in a **format of a PC card** and a **fingerprint sensor module** which is **coupled** to the chip card reader. (Claims 1 and 12)(emphasis added).

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Mathurin fails to teach or suggest a chip card reader in the format of a PC card. Mathurin teaches a credit card finger print reading apparatus 10 on top of a table 28. (Mathurin, FIG. 1, col. 14, ll. 6-23). Apparatus 10 taught by Mathurin, however, is not in the format of a PC card. In fact, the Examiner admits that Mathurin does not teach a chip card reader in the format of a PC card. (02/13/03, Office Action, p. 3). Because Mathurin does not teach or suggest a chip card reader in the format of a PC card, it cannot teach or suggest a "fingerprint sensor module" coupled to the PC card.

Ishii fails to cure the deficiencies of Mathurin. Ishii teaches a writing mechanism 120 to receive an authorized cryptosystem device 200. (Ishii, FIG. 1, col. 7, ll. 26-44). Neither writing mechanism 120 or authorized cryptosystem device 200 are coupled to a fingerprint sensor module.

Additionally, regarding independent claim 1, neither Mathurin nor Ishii, individually or in combination, teach that the fingerprint sensor modules comprises an interface for a connection to a network, as recited in claim 1. The Examiner admits that the fingerprint scanner 22 of Mathurin lacks an interface for a connection to a network. Since Ishii completely lacks a fingerprint sensor, it cannot teach or suggest such an interface, as recited in claim 1.

Therefore, for at least the above reasons, claims 1-12 are allowable over Mathurin in view of Ishii. Given that claims 2-11 depend on claim 1, claims 2-11 are allowable over Mathurin in view of Ishii for at least the same reasons noted above.

Moreover, it is respectfully submitted that neither Mathurin nor Ishii teach or suggest a combination with each other. In particular, these references are directed to systems for different purposes. For instance, Mathurin teaches matching fingerprints

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with one contained in a credit card (Mathurin, Abstract) and Ishii teaches a secret key of a public key cryptosystem (Ishii, Abstract). Thus, it would be impermissible hindsight based on Applicant's own disclosure to combine the teachings of those references. Furthermore, even if the references were combinable, these references would still fail to teach or suggest at least the above claim elements noted above.

Conclusion

In view of the foregoing remarks, Applicant respectfully submits that claims 1-12 are allowable over the cited art of record and are in condition for allowance. Applicant requests the Examiner to reconsider and withdraw the above rejection to the claims culminating in allowance of the claims.

If the Examiner believes a telephone conference would expedite the allowance of the claims, the Examiner is invited to contact Sang Hui Michael Kim at (650) 849-6680.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: July 14, 2003

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Signed: Linda Phillips
Linda Phillips